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In re Application of	:	
EBERL	:	
Serial No.: 10/551,443	:	DECISION ON
PCT App. No.: PCT/EP01/11634	:	
Int'l Filing Date: 08 October 2001	:	RENEWED PETITION
Priority Date: 07 October 2000	:	
Attorney Docket No.: 101795.56306US	:	UNDER 37 CFR 1.137(b)
For: DEVICE AND METHOD FOR DETER-	:	
MINING THE ORIENTATION OF AN EYE	:	

This decision is in response to applicant's renewed petition to revive under 37 CFR 1.137(b) filed 08 August 2006 in the above-captioned application in the United States Patent and Trademark Office (USPTO).

### **BACKGROUND**

On 08 October 2001, applicant filed international application PCT/EP01/11634 which claimed priority to an earlier application filed 02 October 2000. The thirty-month period for paying the basic national fee in the United States expired at midnight on 07 April 2003.

On 29 September 2005, applicant filed a request for entry into the U.S. national stage along with a petition under 37 CFR 1.137(b).

On 08 June 2006, a decision dismissing applicant's petition was mailed, questioning whether the delay on the part of the party having the right or authority to reply to avoid abandonment (or not reply) was unavoidable or unintentional under 37 CFR 1.137.

On 08 August 2006, Petitioner filed a renewed petition under 37 CFR 1.137(b).

### **DISCUSSION**

A petition under 37 CFR 1.137(b) requesting that the application be revived on the grounds of unintentional abandonment must be accompanied by (1) the required reply, (2) the petition fee required by law, (3) a statement that "the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to this paragraph was unintentional" and (4) any terminal disclaimer and fee pursuant to 37 CFR 1.137(c) (where

required). Petitioner has satisfied items (1)-(2) and item (4) does not apply.

Regarding item (3), as stated above, the thirty-month period for paying the basic national fee in the United States expired at midnight on 07 April 2003. Applicant asserts that "it was not possible for any inventor to file in the US because the inventors were not the Applicant of the PCT and could not be until ownership was transferred or release[d] to inventors." However, a review of the international applicant PCT/EP01/11634 indicates that the inventors were also applicants. See indication 75 of the published international application where Roland H. C. Eberl, Heinrich A. Eberl, and David Dickerson were named applicant/inventors. (Where the national law of the designated State requires that, for the purposes of the designation of that State, the applicant(s) must be the inventor(s). See Article 27(3) and PCT Rule 18.4(c).) U.S. national law requires the inventor to be applicant for a patent. See 35 U.S.C. 101 et seq.

When the issue of revival is addressed, the focus must be on the rights of the parties as of the time of abandonment. See Kim v. Quigg, 781 F. Supp. 1280, 1284, 12 USPQ2d 1604, 1607 (E.D. Va 1989). The record is not clear as to the rights of the parties on 07 April 2003, the date of abandonment. Rather, it appears that the instant application was among the assets of a bankruptcy estate. As such, the person who had control of this asset at the date in question would appear to be the bankruptcy trustee.

As noted in MPEP 711.03(c)II(E), the question under 37 CFR 1.137 is whether the delay on the part of the party having the right or authority to reply to avoid abandonment (or not reply) was unintentional. Accordingly, any renewed petition must clearly identify the party having the right to reply to avoid abandonment on 07 April 2003. That party, in turn must explain what effort(s) was made to file a US national stage application and further, why no such application was filed. If no effort was made to file such application, then that party must explain why the delay in filing this application does not result from a deliberate decision to take no action. Likewise, the party having the right or authority to avoid abandonment should explain why this application became abandoned while it was under their control and what efforts were made to file a US national stage application and with whom this matter was discussed. Copies of any correspondence relating the filing, or not filing a US national stage application are required. It is noted that simply because bankruptcy is involved does not necessarily mean that no income was derived to the estate, that there were no funds in the bankruptcy estate, or that no bills were paid or expenses undertaken by the trustee. Simply put, a course of conduct resulting in a delay that is purposefully chosen does not qualify as unintentional delay.

Petitioner states that by virtue of German employment law, Physoptics Opto-Electronic GmbH took over the right to this application and later went into bankruptcy. Their "trustee refused to release their right to this application and refused to initiate the US national phase." It appears that the trustee's refusal to initiate a US national stage application was intentional and thus, the application can not be considered to be unintentionally abandoned.

Petitioner states that "it is not clear that Mr. Dickerson could have filed before the

expiration of the time period for entering the National Stage in the US" and "practical items must be considered, such as expense of filing and how that expense would be shared with respect to the "other" owners.... these matters had to be worked out from a business point of view before proceeding to file even assuming that Mr. Dickerson had obtained a theoretical right to file an application after he settled the lawsuit".

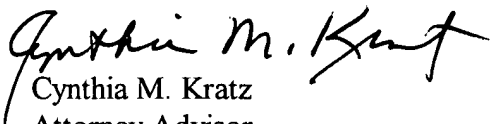
Thus, it appears that the PCT application was subject to the bankruptcy trustee's control and the "other owners". Petitioner has not detailed the time period since 07 April 2003 until the filing of the present petition. Applicant has not provided a detailed account of the knowledge and actions of the bankruptcy trustee and the other owners for the period of 07 April 2003 through the filing of the petition on 29 September 2005. If the trustee knew of the 30 month deadline for entering the National stage in the United States and did not divert funds to either timely enter the U.S. National stage or make arrangements for revival; the lack of such actions could be construed as intentional abandonment. Absent a more detailed explanation of the knowledge and actions of the trustee and the other owners, it is not possible to grant applicant's petition. The question under 37 CFR 1.137 is whether the delay on the part of the party having the right or authority to reply to avoid abandonment (or not reply) was unavoidable or unintentional.

### CONCLUSION

For the reasons above, applicant's petitions under 37 CFR 1.137(b) is **DISMISSED**. The application remains **ABANDONED** as to the United States of America.

Any reconsideration on the merits of this petition must be filed within **TWO (2) MONTHS** from the mail date of this decision. Any reconsideration request should include a cover letter entitled "Renewed Petition Under 37 CFR 1.137(b)." No additional petition fee is required.

Any further correspondence with respect to this matter should be directed to Mail Stop PCT, Commissioner for Patents, Office of PCT Legal Administration, P.O. Box 1450, Alexandria, Virginia 22313-1450, with the contents of the letter marked to the attention of the Office of PCT Legal Administration.



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